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| APPLICATION NO.                    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/673,104                         | 09/26/2003  | Eisaku Katoh         | KON-1827            | 2019             |
| 20311                              | 7590        | 03/10/2005           | EXAMINER            |                  |
| MUSERLIAN, LUCAS AND MERCANTI, LLP |             |                      | SCHWARTZ, PAMELA R  |                  |
| 475 PARK AVENUE SOUTH              |             |                      | ART UNIT            |                  |
| 15TH FLOOR                         |             |                      | PAPER NUMBER        |                  |
| NEW YORK, NY 10016                 |             |                      | 1774                |                  |

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/673,104

Applicant(s)

KATOH ET AL.

Examiner

Pamela R. Schwartz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uto (6,616,991). The reference discloses an ink jet recording material comprising a support with an ink receiving layer thereon (see the abstract). The ink receiving layer may include a liquid polyisoprene or polybutadiene in order to impart viscosity to the layer and to strongly fix coloring agent (see col. 3, line 33-63). The reference discloses a preference for a material with no unsaturated double bonds, and indicates that materials with unsaturated double bonds will not have as high a resistance to light and heat (see col. 3, line 63 to col. 4, line 10). The reference does not disclose the number of carbon atoms per molecule, but from the materials utilized in the examples, it appears that this limitation is met by materials used therein. It would also have been obvious to one of ordinary skill in the art to determine the size of the molecule and the specific molecular configuration from those commercially available in order to obtain desired properties disclosed by the reference such as viscosity modification and colorant fixing ability (see col. 3). In the examples of the reference, the polybutadiene or polyisoprene is present in amount of not less than 60 wt. % of the polymer. The ink receiving layer of the reference is porous and may contain silica or alumina therein (see col. 4, lines 40-59). Polyvinyl alcohol may also be included and may be cationic (col. 4, line 59 to col. 5, line 12). Snowtex-O® used in the examples of the reference, has a particle size of 20 nm. In addition, fluorescent whitening agents, UV ray absorbers and surfactants may be included (see col. 5 as set forth above). Such materials are conventional in the art and therefore, determination of a specific polyvinyl alcohol and a conventional UV ray absorber would have been obvious to one of ordinary skill in the art. Finally, it is known

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in the art to include antimicrobial agents in ink receiving layers. Consequently, it would have been obvious to one of ordinary skill in the art to include such a material for its concomitant function in the art.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/655,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application discloses an ink jet recording sheet comprising a support and an ink receptive layer thereon comprising binder, pigment and polybutadiene having a number average molecular weight of 500 to 10000. Inclusion of cationic polymer and the particle size of the particles are disclosed. The remainder of applicants additives and materials are conventionally known in the art for their specific functions, i.e. UV absorber, fluorescent whitener, surfactant, binder, and antimicrobial agent. Consequently, their inclusion to

serve these functions in the medium would have been obvious variations to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
March 5, 2005

A handwritten signature in black ink, appearing to read 'Pamela Schwartz', with a stylized flourish extending to the right.